

Remarks

Claims 1-28 are pending in the Application.

I. Rejections under 35 U.S.C. § 103

Independent claims 1, 12 and 26

Claims 1, 12 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,910,809 to Grau et al. ("Grau") in view of U.S. Patent No. 5,621,383 to Yoshiyama ("Yoshiyama"). As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on Grau and Yoshiyama for the following reasons.

1. **Even When Combined, the References Do Not Teach the Claimed Subject Independent claim 26**

Grau and Yoshiyama cannot be applied to reject independent claim 26 under 35 U.S.C. § 103, which provides:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. (emphasis added)

Thus, as provided in MPEP § 2143, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Independent claim 26 recites in part: "an inventory system for providing data about a logical ring-type network and for collecting status data from the ring-type network in a raw format[.]" (emphasis added).

Contrary to claim 26, which discloses a logical network, the combination of Grau and Yoshiyama discloses logical relationships in a physical network. For example, the cited text of Grau recites the following:

A management console interacts with the server to provide a graphical user interface for displaying the atlas on a computer screen in a variety of views that facilitate comprehension of logical relationships between various components of the system. (col. 1, lines 63-67) (emphasis added)

In that regard, Applicant respectfully directs the Examiner's attention to the Microsoft Computer Dictionary (attached hereto as Exhibit A), which recites that "[a] physical network refers to the actual configuration of the hardware forming a network" On the contrary, logical topology "describes the way information moves through the network" Therefore, since Gau recites logic relationships in a physical network, it fails to disclose a logical network, as required by claim 26.

Since neither Grau nor Yoshiyama teaches or suggests the above claimed elements, it is impossible to render the subject matter of claim 26 as a whole obvious, and the explicit terms of the statute cannot be met. Accordingly, the rejection of claim 26 under 35 U.S.C. § 103 should be withdrawn, and claim 26 should be allowed.

2. The Combination of References is Improper
Independent claims 1, 12 and 26

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another compelling reason that the above-cited patents cannot be applied to reject claims 1, 12 and 26 under 35 U.S.C. § 103.

§ 2142 of the MPEP provides:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . the examiner must then make a determination

whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination

Here, neither of the cited references teaches, or even suggests, the desirability of the combination since none teaches the specific arrangement as claimed in claims 1, 12 and 26, as amended.

Thus, it is clear that neither of the cited patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides in § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis added)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case, it is clear that the combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in any of the references for the combination as applied to claims 1, 12 and 26, as amended.

Therefore, for this reason alone, the Examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection of claims 1, 12 and 26, as amended, under 35 U.S.C. § 103 should be withdrawn.

Accordingly, for this reason alone, claims 1, 12 and 26 should be allowed.

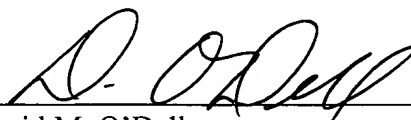
Dependent Claims

Dependent claims 2-11, 13-25, and 27-28 depend from and further limit claims 1, 12 and 26, and should also be allowed.

II. Conclusion

As a result of the foregoing, it is respectfully asserted that the claims in the Application are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



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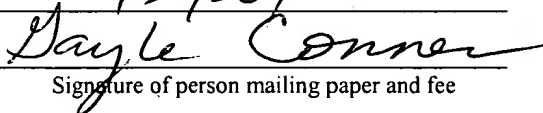
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